

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW S. KISSNER and KEVIN S. WEISS

Appeal No. 2005-1959
Application No. 09/729,394

ON BRIEF



-- Before THOMAS, KRASS, and GROSS, ***Administrative Patent Judges***.

GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10 and 12 through 18, which are all of the claims pending in this application.

Appellants' invention relates to a remote postage meter resetting system having rebate generating capabilities. The rebate is calculated based on the postage refill amount requested, and the user sets the preference for what form the rebate will take. Claim 1 is illustrative of the claimed invention, and it reads as follows:

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1. A method for generating a rebate in a postage meter resetting system, the method comprising the steps of:

receiving a postage refill request at a postage data center to electronically add postage to a postage meter;

determining at the postage data center a rebate value associated with the postage refill request; and

sending the rebate value to a designated location, wherein the rebate value is based on the postage refill amount.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Engel et al. (Engel)	5,907,830	May 25, 1999
Sansone et al. (Sansone)	5,909,373	Jun. 01, 1999
Walker et al. (Walker)	6,018,718	Jan. 25, 2000

Claims 1, 3, 4, 10, 14, and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sansone.

Claims 2 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sansone.

Claims 5, 7 through 9, 12, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sansone in view of Walker.

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Claims 6¹ and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sansone in view of Walker and Engel.

Reference is made to the Examiner's Answer (Paper No. 16, mailed November 24, 2004) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 13, filed December 9, 2003) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the anticipation rejection of claims 1, 3, 4, 10, 14, and 15 and the obviousness rejections of claims 2, 5 through 9, 12, 13, and 16 through 18.

Regarding the anticipation rejection, each of independent claims 1 and 10 recites that the rebate value is based on the postage refill amount. Appellants argue (Brief, page 7) that the rebate amounts in Sansone are "based upon prior postage meter

¹ We note that the rejection of claim 6 on page 5 of the Answer is only over Engel. However, since claim 6 depends from claim 5, which required Sansone and Walker, and since the explanation of the rejection of claim 6 refers to Walker, we assume that the examiner meant to include Sansone and Walker in the rejection of claim 6.

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transactions," rather than on the postage refill amount. We agree. As pointed out by appellants (Brief, page 7), Sansone discloses (column 3, lines 34-42) that the information received by the rebate processor includes identification numbers for the kiosk and postal meter, the time and date of each postal transaction, and the type of each postal transaction. Sansone does not disclose that the rebate processor receives information regarding the postage refill amount. Thus, Sansone fails to disclose or suggest each and every element of independent claims 1 and 10. Accordingly, we cannot sustain the anticipation rejection of claims 1, 3, 4, 10, 14, and 15.

Claims 2 and 13 have been rejected under 35 U.S.C. § 103(a) over Sansone alone. Since claims 2 and 13 depend from claims 1 and 10, respectively, the rejection of claims 2 and 13 suffers from the same deficiencies as the rejection of claims 1 and 10. Therefore, we cannot sustain the obviousness rejection of claims 2 and 13.

As to claims 5, 7 through 9, and 12, the examiner combines Walker with Sansone asserting (Answer, page 4) that Walker teaches that a rebate can be in the form of a certificate. However, Walker is directed to rebates for credit card usage and fails to overcome the shortcomings of Sansone with respect to the

limitations of the independent claims. Consequently, we cannot sustain the obviousness rejection of claims 5, 7 through 9, and 12.

The examiner also rejects claims 17 and 18 over Sansone in view of Walker. Independent claim 17 does not include the limitation found lacking from Sansone regarding how the rebate is calculated. Thus, up to the last paragraph of claim 17 is disclosed by Sansone. However, claim 17 includes a limitation that with the postage refill request is sent a user preference for the form that the rebate is to take, where the choices are a check, an electronic transfer of funds, an account credit, an electronic transfer of postage, or a certificate. We note that choices for rebates are well-known. For example, Discover Card offers a choice of several types of rebates for credit card usage. However, the examiner has failed to provide any evidence that discloses such rebate choices. Walker merely states that different people like different types of rebates, and, therefore, gives different types of rebates to different users. However, Walker does not give the user a choice of the type of rebate that will be given. Thus, on the record before us, we cannot sustain the obviousness rejection of claims 17 and 18.

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Last, the examiner adds Engel to the combination of Sansone and Walker to reject claims 6 and 16. Engel fails to cure the deficiencies of Sansone and Walker described *supra*. Therefore, we cannot sustain the rejection of claims 6 and 16.

CONCLUSION

The decision of the examiner rejecting claims 1, 3, 4, 10, 14, and 15 under 102(b) and claims 2, 5 through 9, 12, 13, and 16 through 18 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
ERROL A. KRASS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
ANITA PELLMAN GROSS) AND
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